



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,859	05/11/2006	Jun Kitahara	09947.0009	3333
22852	7590	03/17/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VAUGHAN, MICHAEL R	
			ART UNIT	PAPER NUMBER
			2431	
			MAIL DATE	DELIVERY MODE
			03/17/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,859

Applicant(s)

KITAHARA ET AL.

Examiner

MICHAEL R. VAUGHAN

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **1/21/10** has been entered.

Claims 2-5, 7, and 8 are pending. Claims 2, 7, and 8 have been amended.

Response to Amendment

Claim Objections

The previous claim objection has been overcome by amendment to the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In attempting to clarify the invention, Applicant introduces a limitation which states that the first and second sublicenses are acquired **before** the first content is acquired. This limitation is not supported by the original specification. The specification discloses that the first content is combined with the first and second sublicenses and they are sent together (see Fig. 5, 101). Both the sublicenses and the content are deemed acquired at step 101. Also from page 58 of the specification, it is clear that the first and second sublicenses are acquired concurrently (step S131 of Fig. 18) with the first content. It is supported that the first and second sublicenses are acquired before the **second** content but not the first content. In the previous Office Action, Examiner pointed out that the phrase "along with" was not narrow enough to require the interpretation of simultaneous arrival as argued by Applicant. "Along with" was simply interpreted as indicating a list of things acquired by the apparatus. Applicant had argued that the first and second sublicenses were arriving subsequently after the first content and before the second content is acquired (see page 8 of remarks filed 8/20/09). This line of argument was supported in the specification, but not supported by the scope of the claims.

Thus, the newly amended claims fail to comply with the written description requirement because the limitation of the first and second sublicenses acquisition before the first content is not supported by the original disclosure.

Response to Arguments

Applicant's arguments filed 12/22/09 have been fully considered but they are not persuasive.

With respect to the argument that Revital does not teach "the sublicense acquisition acquires ... the second sublicense corresponding to the second content before the first content is acquired", Examiner respectfully disagrees. First, as indicated above, the original disclosure lacks support for interpreting this statement as argued. Interpreting this limitation broadly and in light of the original specification, one can see (Fig. 5 for example) that the first and second sublicenses are acquired before the first content is reproduced. For purpose of examination this interpretation is being applied. As such Revital teaches time and time again of VECM/ECM, which are associated with scrambled content, preceding both the arrival and reproduction of said content (col. 3, lines 5-15, col. 6, lines 20-25, and col. 16, lines 5-15). Each VECM/ECM can be associated with particular items or portions of protected content (col. 8, lines 43-45 and col. 10, lines 63-65). No matter how one divides the data into content or portions of contents, the ECM keys/control words are sent to the receiver prior to the scrambled data's reproduction. There is no time where the user would be interrupted from the content because the receiver is waiting for the ECM. Once content is being reproduced,

future ECMs would be sent in order to decrypt the other portions of the data. The claims' first content and second content do not require they are unrelated. They are being interpreted as portions of the content stream. As such, when Revital teaches sending a second layer of keys (emphasis on more than one key; col. 8, lines 46). It is understood that they would be used to decrypt subsequent content. It is understood from Revital's invention that this above process is occurring and the claims do not require anything more than what is taught or rendered obvious by Revital.

With respect to the allegation that Revital fails to teach the newly added limitation "wherein the main condition and the subcondition include at least one of a time period in which the plurality of contents may be reproduced and a number of times the plurality of contents may be reproduced", Examiner respectfully disagrees. All that is required by the limitation is that both the main condition and the subcondition include at least one of the two features. Mapping the main condition to that of Revital's VEMM, col. 6, lines 35-40 disclose a time condition associated with the VEMM. The content could not be reproduced if that epoch has expired. Mapping the subcondition to Revital's ECM/VECM, col. 14, lines 1-5 disclose a cryptographic time period associated with the ECM. As with the main condition, once this time period elapses the content would not be able to be displayed. Therefore, both the VEMM and VECM have conditions that limit the time period in which the content may be reproduced. These two teachings satisfy the new limitation. Not that it is required but, Revital also suggests the notion of limiting the number of time content can be displayed (col. 1, line 34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable
USP 7,739,548 to Revital et al, hereinafter Revital in view of USP Application
Publication 2002/0001386 to Akiyama.

As per claim 2, Revital teaches an information processing apparatus adapted for processing a plurality of contents provided by a contents distribution service having a channel for distributing the plurality of content (col. 10, lines 5-7) including a first content and a second content distributed after the first content, the information processing apparatus comprising:

main license acquisition means for acquiring a main license [VEMM] having a main condition [access to protected content] applied in common for the plurality of contents, the main license further including main license key information (col. 5, lines 5-7 and col. 10, lines 10-15);

sublicense acquisition means for acquiring, a plurality of sublicenses [VECM's] that correspond to the plurality of contents (col. 5, lines 9-10) and are provided in a

manner different from the main license [criteria packaged into VECM as apposed to VCMM], the plurality sublicenses including subconditions for the plurality of contents (col. 9, lines 35-40), identification information of the main license (col. 6, lines 24-25), sublicense key information (col. 5, lines 45-47) the plurality of sublicenses including a first sublicense corresponding to the first content and a second sublicense corresponding to the second content [col. Assess to particular items or portions of protected content; col. 8, lines 44-45);

control means for controlling reproduction of the plurality of contents when the main condition of the main license and subconditions of the plurality of sublicenses are satisfied [properly decrypted] (col. 5, lines 35-37);

wherein when the plurality of contents are distributed via the channel successively in terms of time, the sublicense acquisition means acquires, (col. 6, lines 20-23) the first sublicense corresponding to the first content and the second sublicense corresponding to the second content before the first content is acquired, and the control means determines, while the first content is being acquired, whether the main condition prescribed by the main license and the subcondition prescribed by the second sublicense are satisfied, and reproduces the second content after reproducing the first content [follows the natural process of streaming content whereby the keys are streamed just prior to needing them for decryption] when the main condition prescribed by the main license and the subcondition prescribed by the second sublicense are both satisfied (col. 3, lines 5-15); and.

wherein the main condition and the subcondition include at least one of a time period in which the plurality of contents may be reproduced (VEMM; col. 6, lines 35-40; ECM; col. 14, lines 1-5] and a number of times the plurality of contents may be reproduced.

Revital is silent in explicitly disclosing the first license has a digital signature and that second license further includes identification information of a first license corresponding to the second license, second key information, and an electronic signature. Akiyama teaches using digital signatures to secure the transportation of licenses (0107). Akiyama goes on to teach why using digital signatures secure transactions from alteration (0113). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature to the licenses of Revital to ensure the licenses are not altered.

As per claim 3, Revital teaches that during the manufacture of the recipient module an embedded key is stored in the hardware (col. 4, lines 38-42). Revital also teaches that any method of suitable encryption mechanism may be used for encrypting the various types of keys in his invention (col. 9, lines 52-53). Even though Revital does not explicitly call any of the secret keys, public-keys, it would be obvious to one of ordinary skill in the art that public key cryptography could easily be used in this case. The private stored key in the device would be the device's own unique private key. Then, any entity who wishes to create a session key (as taught by Revital and Akiyama) would simply encrypt the session key with the device's public key so only that specific

device could decrypt the message and obtain the session key. Revital even teaches encrypting one key with another. Akiyama teaches public key cryptography as means of transmitting license information (0111). This is a well established algorithm of key exchange. Anyone of ordinary skill in the art would readily use this algorithm. Therefore it would have obvious to one of ordinary skill in the art at the time of the invention to use the well known public key cryptography as a suitable encryption mechanism as Akiyama teaches.

As per claim 4, Revital teaches the second key included in the second license is encrypted and the control means decrypts, by using the first key information, encrypted second key information and uses the second key information to decrypt the acquired content (col. 5, lines 10-16).

As per claim 5, Revital teaches license management means for allowing any other information processing apparatus to permit utilization of the plurality of contents when the main condition prescribed by the main license and the subconditions prescribed by the plurality of sublicenses are both satisfied (col. 5, lines 31-34).

Claims 7 and 8 are rejected for the same reasons as claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is

(571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431